

REMARKS

In response to the Office Action of May 10, 2000, independent claims 29, 42, and 52 have been amended. Claims 29-56 are pending in the application. Consideration of the instant amendment and withdrawal of the present rejection of the claims are respectfully solicited.

In paragraph 1 on page 2 of the Office Action, the Examiner rejected claims 2-13 under 35 U.S.C. §112. Respectfully, it appears that the Examiner may have overlooked Applicant's cancellation of original claims 2-28 in Applicant's filing of the instant continuation application under 37 CFR § 1.53(b) dated March 5, 1998 (see page 2, paragraph 2 of Applicant's continuation application filing document).

In view of the Examiner's apparent oversight, Applicant elects not to address the grounds for rejections as applied to canceled claims 2-28. Applicant's remarks provided herein are, rather, directed only to pending claims 29-56. Applicant respectfully requests that the Examiner acknowledge the state of the pending and previously canceled claims for clarity of the record.

In paragraph 3 on page 3 of the Office Action, the Examiner rejected claims 2-10, 13-38 and 41-56 under 35 U.S.C. 103(a) as being unpatentable over *Abecassis* in view of *Russo et al.* The Examiner also rejected claims 11 and 39 under 35 U.S.C. 103(a) as being unpatentable over *Abecassis* and *Russo* in view of certain facts established by Official Notice. Finally, the Examiner rejected claims 12 and 40 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,751,883.

Concerning the rejection of claim 40, Applicant submits herewith a Terminal Disclaimer executed by Applicant's Representative. It is believed that submission of the instant Terminal Disclaimer obviates the Examiner's obviousness-type double patenting rejection of claim 40.

Concerning the Examiner's rejection of claims 29-38 and 41-56 under 35 U.S.C. 103(a), Applicant has amended independent claims 29, 42, and 52 to

better define features of these claims that are neither taught nor suggested by the combination of *Abecassis* and *Russo*.

Abecassis discloses a video system which includes a random access device that provides for selective inclusion or exclusion of pre-scripted program content based on pre-selected viewer preferences (e.g., level of profanity, violence, bloodshed, etc.). Based on viewer selections, different versions of a given program may be presented which comport with viewer content preferences.

Abecassis further discloses that multiple reading units (e.g., first reading unit 621 and second reading unit 622) are required to read non-sequential video segments from a video source (see, e.g., column 15, lines 43-55). Each of the multiple reading units operates independently of one another, such that the movement of each reading unit is not impaired by the movement of a different reading unit (see, e.g., column 16, lines 27-34).

Russo teaches a video time-shifting system which purportedly provides VCR-like program control capabilities. In a preferred embodiment, a magnetic disk drive is employed to store video-based programming. The system disclosed in *Russo* employs a pair of write heads which are controlled by one actuator and a pair of read head which are controlled by a second actuator (see, e.g., Figure 1 of *Russo*).

In particular, *Russo* teaches that the disk drive is provided with "independent read/write heads, one set being employed for recording, and the other being used for playback, using separately controlled actuators so that the heads do not interfere mechanically" (*Russo*, column 5, lines 62-67). The dual actuators are apparently necessary to overcome several detrimental consequences of performing repeated write, repositioning, and read operations (*Russo*, column 5, line 67-column 6, line 14).

To establish a *prima facie* case of obviousness, three basic criteria must be met:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(M.P.E.P. §2142).

Applicant has amended claim 29 to include additional features of a common actuator having elongated arms and a transducer comprising read and write elements disposed on each of the elongated arms. Claim 42 has also been amended to include these additional features.

Further, claim 52 has been amended to recite a direct access storage device which includes the additional feature of at least one pair of read/write transducers arranged for simultaneous movement by a common actuator. Claim 52 has been further amended to recite the feature of moving the common actuator to sweep the read/write transducers repeatedly between respective inner and outer diameter locations of the at least one data storage disk. The writing and reading operations of claim 52 are performed while moving the common actuator.

Applicant's claimed subject matter provides for the transferring of video information between read/write transducers and a disk surface using a common actuator. The systems taught in *Abecassis* and *Russo* or any system resulting from a combination of the *Abecassis* and *Russo* teachings require at least two independent actuators.

In this regard, Applicant's claimed subject matter performs the required video information transfer function using a common actuator, whereas the systems of *Abecassis* and *Russo* require two or more actuators to perform their respective video information transfer functions. Omission of an element (i.e., a second or additional actuator) and retention of its function (i.e., video information

transfer) is an indicia of unobviousness (M.P.E.P. § 2144.04, section II-B, citing *In re Edge*, 149 USPQ 556 (CCPA 1966)).

The combination of *Abecassis* and *Russo* fails to teach or suggest a common actuator for moving read/write transducers. Rather, the combination of references teaches that at least two independently controlled actuators are required to transfer video data to and from a storage disk to achieve the desired ordering of video information stored in the disk.

The asserted combination further fails to teach or suggest a mechanism or process by which source program segments are transferred to and from data storing regions of a data disk using a common actuator, such that non-chronologically ordered source program segments written to the data storing regions are read as chronologically ordered local program segments.

Accordingly, the asserted combination fails to teach or suggest all of the features recited in Applicant's amended claims 29, 42, and 52. For this reason alone, these claims cannot be found obvious in view of the combination of *Abecassis* and *Russo*.

Respectfully, no motivation to combine these reference teachings can be found in *Abecassis* and/or *Russo*. It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be "clear and particular." *In re Dembicza*k, 50 USPQ2d 1614 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of references, standing alone, are not evidence. *Id.*

Rather than providing a motivation to combine the reference teachings to arrive at Applicant's claimed subject matter, it would appear that the detrimental consequences of using a common actuator described in *Russo* would strongly suggest that one skilled in the art would not be motivated to combine these references in the manner suggest by the Examiner. Moreover, the combination of *Abecassis* and *Russo* fails to provide a reasonable expectation of success.

Because the combination of references, knowledge possessed by one of ordinary skill in the art, and the Officially Noticed facts fails to teach or suggest several of the above-identified limitations and because no motivation or

suggestion to combine the references/knowledge/facts can be identified in the references themselves, and further because the asserted combination does not provide a sufficient basis to support a reasonable expectation of success, Applicant respectfully asserts that the Examiner has failed to establish *prima facie* obviousness of Applicant's subject matter recited in independent claims 29, 42, and 52, as amended, and claims 30-41, 42-51, and 53-56 which respectively depend therefrom.

Applicant submits that claims 29-56 are in condition for allowance. Reconsideration and withdrawal of the rejections are requested. The Examiner is invited to contact Applicants' Representative at the below-listed number if it is believed that prosecution can be expedited thereby.

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